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FACSIMILE TRANSMISSION

DATE: October 27, 2003 **MATTER NUMBER:** IOWA:040US / 10107393

RECIPIENT:	FAX NO.:	PHONE NO.:
John Doll - 1600 Technology Center Director With the United States Patent and Trademark Office	703-308-4407	

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RE: Serial No. 09/871,607

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October 27, 2003

CERTIFICATE OF FACSIMILE TRANSMISSION
37 C.F.R. § 1.8

I hereby certify that this correspondence is being transmitted to: Commissioner for Patents, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-01450, Attn: John Doll, Technology Center Director, facsimile number (703) 308-4407 on the date below:

October 27, 2003
Date

Steven L. Highlander

Commissioner for Patents
Attn: Technology Center Director – Mr. John Doll
Technology Center 1600
P.O. Box 1450
Alexandria, VA 22313-01450

Re: Serial Number 09/871,607 entitled "TOPOISOMERASE ACTIVATED OLIGONUCLEOTIDE ADAPTORS AND USES THEREFOR" by Timur Yarovinsky
Our ref: IOWA:040US / Matter No. 10107393

Commissioner:

Enclosed for filing in the above-referenced patent application is:

1. Petition to Withdraw Finality of Office Action; and

2. A return postcard to acknowledge receipt of these materials. Please date stamp and mail this postcard.

25349549.1

Should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to the enclosed materials, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/IOWA:040US/SLH.

Very truly yours,

Steven L. Highlander

SLH/cpj
Encl: As noted

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Timur YAROVINSKY	
Serial No.: 09/871,607	Group Art Unit: 1634
Filed: May 31, 2001	Examiner: C. Myers
For: TOPOISOMERASE ACTIVATED OLIGONUCLEOTIDE ADAPTORS AND USES THEREFOR	Atty. Dkt. No.: IOWA:040US/SLH

CERTIFICATE OF FACSIMILE TRANSMISSION
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I hereby certify that this correspondence is being transmitted to: Commissioner for Patents, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-01450, Attn: John Doll, Technology Center Director, facsimile number (703) 308-4407 on the date below:

October 27, 2003
Date

Steven L. Highlander

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION

Commissioner for Patents
Attn: Technology Center Director – Mr. John Doll
Technology Center 1600
P.O. Box 1450
Alexandria, VA 22313-01450

Sir:

On August 27, 2003, a final Office Action was issued in connection with the above-captioned application. It is believed that the finality of the action was improper, and reconsideration of the finality is respectfully requested. No fees are believed due in connection with this filing; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to these materials, the Commissioner is hereby authorized to deduct said fees from Fulbright & Jaworski Deposit Account No.: 50-1212/IOWA:040US/SLH.

FACTS IN SUPPORT OF PETITION

In the Office Action mailed on August 27, 2003, the examiner entered a new ground of rejection for claim 2, based on alleged lack of novelty over Wang (U.S. Patent 5,932,451), a newly cited reference. Applicant's representative contacted the examiner regarding this rejection, and the examiner indicated that the finality of the rejection was believed proper.

The only relevant changes made to claim 2 in the response of April 14, 2003 were to: (a) limit the Markush group therein, reciting two cleavage motifs (CCCTT and TCCTT), to one (TCCTT), and (b) to limit the first functional nucleotide sequence to a Markush group of 7 particular sequences, all previously found in canceled claim 3 (effected by amendment of claim 1, from which claim 2 depends). Wang is said to teach the TCCTT motif and a plurality of first functional nucleotide sequences. Clearly, if the rejection over Wang is proper, it could have been advanced previously. Thus, applicants' amendments did not necessitate the rejection.

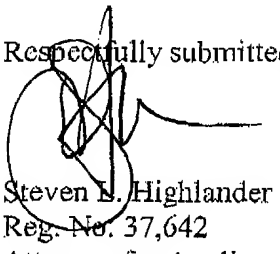
As admonished by MPEP §706.07, "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed." And while an applicant who "dallies in the prosecution" or resorts "to technical or other obvious subterfuges in order to keep the application pending" is not entitled to perpetual non-final actions, that clearly is not such a case here. MPEP §706.07. Much to the contrary, applicants merely introduced the limitations of claims 2 and 3 into claim 1, and amended claim 2 by dropping one of two possible sequences. Thus, it is submitted that the instant application is one where "a second or subsequent action ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to

include limitations which should reasonably have been expected to be claimed." MPEP §706.07(a).

PRAYER FOR RELIEF

In light of the foregoing, applicant respectfully request removal of the finality of the instant office action. Questions regarding the instant petition may be directed to the undersigned at the telephone number listed below.

Respectfully submitted,



Steven L. Highlander
Reg. No. 37,642
Attorney for Applicant

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600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 474-5201

Date: October 27, 2003

MARKED UP COPY OF CLAIMS 1-22 AS AMENDED ON APRIL 14, 2003

1. (Amended) A nucleic acid with a 5' end and a 3' end comprising a first functional nucleotide sequence and a scissile strand topoisomerase I cleavage motif sequence selected from the group consisting of CCCTT and TCCTT, wherein the scissile strand topoisomerase I cleavage motif sequence is located 3' to the first functional nucleotide sequence and provides a scissile strand topoisomerase I cleavage site that is not more than 10 bases from the 3' end of the nucleic acid, wherein the first functional nucleotide sequence is selected from the group consisting of a prokaryotic promoter sequence, a eukaryotic promoter sequence, a viral promoter sequence, a polypeptide tag encoding sequence, a terminator sequence, a fusible protein encoding sequence and an intronic sequence.

2. (Amended) The nucleic acid of claim 1, wherein the scissile strand topoisomerase I cleavage motif sequence is [selected from the group consisting of: CCCTT and] TCCTT.

3. (Canceled)

4. (Amended) An adaptor comprising a first nucleic acid with a 5' end and a 3' end comprising a scissile strand topoisomerase I cleavage motif having a 5' motif sequence contiguous with a 3' motif terminal [nucleotide] T, said 5' motif sequence being selected from the group consisting of CCCT and TCCT and providing a scissile strand topoisomerase I cleavage site that is not more than 10 bases from the 3' end of the first nucleic acid, said 3' motif terminal [nucleotide] T being contiguous with a palindromic sequence of not less than two nucleotides nor more than 10 nucleotides and said palindromic sequence being contiguous with a 3' end [nucleotide that is complementary to the 3' motif terminal nucleotide of the scissile strand topoisomerase I cleavage motif] A.

5. (Amended) The adaptor of claim 4, further comprising a second nucleic acid having a 5' end sequence that is complementary to the 5' sequence of the scissile strand topoisomerase I cleavage motif.

6. (Amended) The [first nucleic acid of the] adaptor of claim 4, wherein [the 3' motif terminal nucleotide of the scissile strand topoisomerase I cleavage motif is T and] the 5' motif sequence of the scissile strand topoisomerase cleavage motif is [selected from the group consisting of CCCT and] TCCT.

7. (Amended) The [first nucleic acid of the] adaptor of claim 4, further comprising a restriction endonuclease site located 5' to the scissile strand topoisomerase I cleavage motif.

8. (Amended) The [first nucleic acid of the] adaptor of claim 4, further comprising a 5' end sequence that is complementary to the 5'-overhang of a restriction endonuclease site.

9. (Amended) The [first nucleic acid of the] adaptor of claim 7 or claim 8, wherein the restriction endonuclease is selected from the group consisting of[:] BamH I, Bgl II, Cla I, Dde I, Eae I, Eag I, EcoR I, Hind III, Kas I, Mbo I, Mlu I, Nco I, Nde I, Nhe I, Not I, PaeR7 I, Sal I, Sau3A, SpeI, Sty I, Xba I, Xha I, Xho I and Xma I.

10. (Amended) The [first nucleic acid of the] adaptor of claim 4, further comprising a first functional nucleotide sequence selected from the group consisting of[:] a prokaryotic promoter sequence, a eukaryotic promoter sequence, a viral promoter sequence, a mutational sequence, a polypeptide tag encoding sequence, a nucleic acid tag sequence, a terminator sequence, a fusible protein encoding sequence, a radioactively labeled nucleotide sequence, a chemically labeled nucleotide sequence and an intronic sequence.

11-20. (Canceled)

21. (New) The nucleic acid of claim 1, wherein the scissile strand topoisomerase I cleavage motif sequence is CCCTT.

22. (New) The adaptor of claim 4, wherein the 5' motif sequence of the scissile strand topoisomerase cleavage motif is CCCT.